UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,650	09/15/2003	Yoichi Kanai	242873US2	9352

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EXAMINER
MILIA, MARK R

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
12/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

		Application No.	Applicant(s)
Office Action Summary		10/661,650	KANAI ET AL.
		Examiner	Art Unit	
		Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 October 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,12-15,21 and 22* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,12-15,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of claims 1-6, 12-15, and 21-22 in the reply

filed on 10/10/07 is acknowledged.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-6, 12-15, and 21-22 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter. Claims 1-6, 12-15, and

21-22 are drawn to functional descriptive material NOT claimed as residing on a

computer readable medium.

Claims 1-6, 12-15, and 21-22, while defining a program, does not define a

"computer-readable medium" and is thus non-statutory for that reasons. A program can

range from paper on which the program is written, to a program simply contemplated

and memorized by a person. The examiner suggests amending the claim to embody

the program on "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-6, 12-15, and 21-22 are rejected under 35 U.S.C. 102(b) as being

anticipated by U.S. Patent No. 6,289,450 to Pensak et al., cited in the IDS filed 2/9/04.

Regarding claim 1, Pensak discloses a document printing program comprising

the codes of: obtaining a print requirement associated with a document file (see column

6 lines 18-60) and compulsory executing the print requirement when the document file

is printed out (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 12, Pensak discloses a document protecting program

comprising the codes, of: obtaining an encryption key used to encrypt a document file

(see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65,

column 6 lines 31-60, and column 7 lines 7-36), associating print requirement with the

document file (see column 6 lines 18-60 and column 8 lines 47-56), and encrypting the

document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23

and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36).

Regarding claim 21, Pensak discloses a document protecting system comprising:

a distributor terminal implementing a document protecting program comprising the

codes of: a part obtaining an encryption key to encrypt a document file (see column 2

lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-

60, and column 7 lines 7-36), a part associating a print request to the document file (see

column 6 lines 18-60 and column 8 lines 47-56), and a part encrypting the document file

by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67,

column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user

terminal (see Figs. 1 and 2) implementing a document printing program comprising the

codes of: a part obtaining a decryption key of document file being encrypted (see

column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-

60), a part decrypting the document file based on the obtained decryption key (see

column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-

60), a part obtaining a print requirement associated with the document file (see column

6 lines 18-60 and column 8 lines 47-56), and a part executing a printing process so as

to satisfy the print requirement (see column 8 lines 35-56).

Regarding claim 22, Pensak discloses a document protecting system comprising:

a server implementing a document protecting program comprising the codes of:

obtaining an encryption key used to encrypt a document file (see column 2 lines 10-28,

column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and

column 7 lines 7-36), associating a print requirement with the document file (see column

6 lines 18-60 and column 8 lines 47-56), and encrypting the document file by the

encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5

lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user terminal (see

Figs. 1 and 2) comprising the codes of: obtaining a decryption key of a document being

encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining a print requirement associated with the document (see column 6 lines 18-60 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print requirement (see column 8 lines 35-56).

Regarding claim 2, Pensak further discloses wherein the print requirement is compulsory enforced by executing a printing process with the print requirement when the document file being encoded is decrypted (see column 8 lines 35-56).

Regarding claim 3, Pensak further discloses obtaining a decryption key for the document file being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), decrypting the document file based on the obtained decryption key (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining the print requirement associated with the document file (see column 6 lines 50-55 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print request (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 4, Pensak further discloses wherein the print requirement is obtained from the decrypted document file (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 5, Pensak further discloses wherein a password corresponding to an encryption key used to encrypt the document file is obtained from a user, and an decryption key is generated by the password (see column 2 lines 10-18, column 3 lines 62-65, column 5 lines 59-65, and column 6 lines 17-22 and 31-60).

Regarding claims 6 and 15, Pensak further discloses wherein a parameter, which is internally maintained or generated, is used to generate the decryption key (see column 2 lines 44-57 and column 3 lines 11-25).

Regarding claim 13, Pensak further discloses wherein the document file and the print requirement are associated with each other by providing the print requirement to the document file and then encrypting the document file with the print requirement (see column 6 lines 31-60).

Regarding claim 14, Pensak further discloses wherein an encryption key is generated based on a password input by a user (see column 3 lines 62-65).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.
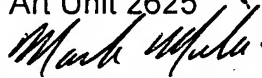
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Haskins can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
Examiner
Art Unit 2625

MRM

TYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER